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### REMARKS

Claim 20 has been amended to overcome a minor formal objection. The remaining claims are resubmitted for reconsideration without amendment in the light of the following authorities and remarks.

2. Claim 20 is objected to because it depends on itself. Claim 20 has been amended to depend upon claim 10. Accordingly, withdrawal of the objection is respectfully requested.

3. Claims 1, 5, 6, 8, 10-12, 16, 17, 21 and 23-25 stand rejected under 35 U.S.C. §102(e) as being anticipated by Clauson. Regarding claims 1, 11, 21 and 25, the reference is said to disclose an acoustic assembly for automobiles comprising an electroacoustical transducer 44 an acoustic element 12, separate from the transducer, and structured to improve the acoustic performance of the transducer, wherein the assembly is an element of a vehicle pillar, with specific reference to FIG. 1. Regarding claims 5, 6, 8, 10, 12, 16, 17, 23 and 24, the reference is said to further disclose the acoustic assembly wherein the acoustic assembly is a sealed acoustic volume of an A-pillar, with specific reference to FIGS. 3 and 1. This ground of rejection is respectfully traversed.

"It is well settled that anticipation under 35 U.S.C. 102 requires the presence in a single reference of all of the elements of a claimed invention." *Ex parte Chopra*, 229 U.S.P.Q. 230, 231 (BPA&I 1985) and cases cited.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983).

"This court has repeatedly stated that the defense of lack of novelty (i.e., 'anticipation') can only be established by a single prior art reference which discloses each and every element of the claimed invention." *Structural Rubber Prod. Co. v. Park Rubber Co.*, 223 U.S.P.Q. 1264, 1270 (Fed. Cir. 1984), citing five prior Federal Circuit decisions since 1983 including *Connell*.

In a later analogous case the Court of Appeals for the Federal Circuit again applied this rule in reversing a denial of a motion for judgment n.o.v. after a jury finding that claims were anticipated. *Jamesbury Corp. v. Litton Industrial Prod., Inc.*, 225 U.S.P.Q. 253 (Fed. Cir. 1985).

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After quoting from *Connell*, "Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim," 225 U.S.P.Q. at 256, the court observed that the patentee accomplished a constant tight contact in a ball valve by a lip on the seal or ring which interferes with the placement of the ball. The lip protruded into the area where the ball will be placed and was thus deflected after the ball was assembled into the valve. Because of this constant pressure, the patented valve was described as providing a particularly good seal when regulating a low pressure stream. The court quoted with approval from a 1967 Court of Claims decision adopting the opinion of then Commissioner and later Judge Donald E. Lane:

[T]he term "engaging the ball" recited in claims 7 and 8 means that the lip contacts the ball with sufficient force to provide a fluid tight seal. \*\*\* The Saunders flange or lip only sealingly engages the ball 1 on the upstream side when the fluid pressure forces the lip against the ball and never sealingly engages the ball on the downstream side because there is no fluid pressure there to force the lip against the ball. The Saunders sealing ring provides a compression type of seal which depends upon the ball pressing into the material of the ring. \*\*\* The seal of Saunders depends primarily on the contact between the ball and the body of the sealing ring, and the flange or lip sealingly contacts the ball on the upstream side when the fluid pressure increases. 225 U.S.P.Q. at 258.

Relying on *Jamesbury*, the ITC said, "Anticipation requires looking at a reference, and comparing the disclosure of the reference with the claims of the patent in suit. A claimed device is anticipated if a single prior art reference discloses all the elements of the claimed invention as arranged in the claim." *In re Certain Floppy Disk Drives and Components Thereof*, 227 U.S.P.Q. 982, 985 (U.S. ITC 1985).

The reference does make reference to a conventional speaker 44; however, the reference does not identify A-pillar 12 as an acoustic element, but only as "a structural member 12." Col. 2, lines 53-54. But the claims call for the acoustic element designed and constructed to improve the acoustic performance of the electroacoustical transducer with the acoustic assembly designed and constructed to be an element of a vehicle pillar. The reference does not disclose the nonexistent acoustic element constructed to improve the acoustic performance of the electroacoustical transducer. The teaching of the reference is, "Speaker assembly 42 is operable for sounding an alarm to alert vehicle occupants to one or more pre-determined conditions such

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as opening a vehicle door ...." Col. 3, lines 37-39, disclosing that speaker 44 has little need for improvement of its acoustic performance. Furthermore, claim 25 calls for an automobile pillar comprising a plurality of sound sources, and nothing in the reference discloses an automobile pillar comprising a plurality of sound sources.

As to claims 5, 6, 8, 10, 12, 16, 17, 23 and 24, the reference fails to disclose a sealed volume, let alone a sealed acoustic volume. Claim 5 calls for the acoustic element being an acoustic volume. The specification on page 5, lines 4-9 states, "The dimensions and any other parameters of the acoustic element are selected to improve the acoustic performance of electroacoustical transducer 24, such as by improving the frequency response of electroacoustical transducer 24, expanding the effective frequency range of electroacoustical transducer 24, or improving the spatial effect of electroacoustical transducer 24." The specification and these rejected claims require that the acoustic volume be such that it must affect the acoustic output of a transducer. Nothing in the reference even remotely suggests that function for the disclosed structure.

What the Examiner has been doing is using the claims being rejected as a blueprint or template for attempting to read the prior art upon the claims.

The alleged teaching is found, not in the references but in the claims being rejected. It is error to reconstruct the claimed invention from the prior art by using the rejected claim as a "blueprint." *Interconnect Planning Corp. v. Feil*, 227 U.S.P.Q. 543, 548 (Fed. Cir. 1985).

Here, the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. <sup>15</sup> This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."<sup>16</sup> *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1784 (Fed. Cir. 1992).

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<sup>15</sup> *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). See also *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).  
<sup>16</sup> *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600.

Accordingly, withdrawal of the rejection of claims 1, 5, 6, 8, 10-12, 16, 17, 21 and 23-25 as anticipated by Clauson is respectfully requested. Should this ground of rejection be repeated,

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the Examiner is respectfully requested to associate each element in each rejected claim with corresponding elements in the reference, and quote verbatim the language in the reference regarded as identifying each corresponding element.

4. Claims 2-4, 13-15 and 22 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Clauson as a primary reference in view of Yanagawa as a secondary reference. Regarding these claims, the primary reference is said to not clearly show a waveguide as claimed. But the secondary reference is said to disclose a stereo sound system for automobile comprising a waveguide, with specific reference to FIGS. 3A and 4A. Therefore, it is said it would have been obvious to one skilled in the art at the time the invention was made to provide waveguide for the acoustic assembly said to be taught by the primary reference in order to provide desirable acoustic sound for users. This ground of rejection is respectfully traversed.

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification."

*In re Gordon*, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984).

Although the Commissioner suggests that [the structure in the primary prior art reference] could readily be modified to form the [claimed] structure, "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1398 (Fed. Cir. 1989).

"The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick*, 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984) (emphasis in original, footnotes omitted).

"The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" *Fromson v. Advance Offset Plate, Inc.*, 225 U.S.P.Q. 26, 31 (Fed. Cir. 1985).

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Nothing in the references remotely suggests the desirability of modifying what is there disclosed to meet the terms of the rejected claims. These rejected claims are dependent upon claim 1, and we have shown above that claim 1 is not met by the primary reference. Therefore, it is impossible to combine the primary and secondary references to form the rejected claims.

"Moreover, we observe that even if these references were combined in the manner proposed by the examiner, that which is set forth in appellant's claims . . . would not result." *Ex parte Bogar*, slip op. p.7 (BPA&I Appeal No. 87-2462, October 27, 1989). "Even if we were to agree with the examiner that it would have been obvious to combine the reference teachings in the manner proposed, the resulting package still would not comprise zipper closure material that terminates short of the end of the one edge of the product containing area, as now claimed." *Ex parte Schwarz*, slip op. p.5 (BPA&I Appeal No. 92-2629 October 28, 1992).

That is reason enough for withdrawing the rejection of claims 2-4, 13-15 and 22 on the combination of references. If this ground of rejection is repeated, the Examiner is respectfully requested to associate each element in each of these rejected claims with corresponding elements in the references, and quote verbatim the language in the references identifying the elements and the language in the references which suggest the desirability of combining what is there disclosed to meet the terms of these rejected claims.

5. Claims 7, 9, 18-20 and 26-29 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Clauson as a primary reference in view of Moriyama as a secondary reference. Regarding these claims, the primary reference is said to not clearly show a second or and third acoustic transducer as claimed, but the secondary reference is said to disclose a loudspeaker system for automobile comprising at least a second transducer 1, 2. Therefore, it is said it would have been obvious to one skilled in the art at the time the invention was made to provide the second or and third transducer for the acoustic assembly said to be taught by the primary reference as an alternate choice, for providing a better acoustic effect for the assembly. Regarding claim 19, the primary reference is said to further disclose the acoustic assembly, wherein the acoustic assembly is a sealed acoustic volume, with specific reference to FIG. 3 of an A-pillar, with specific reference to FIG. 1. This ground of rejection is respectfully traversed.

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There are millions of automobile sound systems with more than one transducer. However, there is nothing in either the primary or secondary reference that even remotely suggests the desirability of having more than one transducer in the A-pillar or in the trim on the A-pillar. As to claim 19, there is no disclosure in the primary reference of an acoustic assembly that is a closed volume. Furthermore, these claims are dependent upon parent claims that we have shown above are not anticipated by the primary reference; therefore, it is impossible to combine the references to form the subject matter of these rejected claims. Accordingly, withdrawal of the rejection of claims 7, 9, 18-20 and 26-29 as unpatentable over the primary and secondary references is respectfully requested. If this ground of rejection is repeated, the Examiner is respectfully requested to associate each element in these claims with corresponding elements in the references, quoting verbatim the language in the references regarded as corresponding to the elements and the language suggesting the desirability of combining what is there disclosed to meet the terms of these claims.

(The courtesy of the Examiner in conducting a diligent search is acknowledged with appreciation. The references cited, but not applied, have been examined and are submitted to be incapable of anticipating, suggesting or making obvious the subject matter as a whole of the invention disclosed and claimed in this application.) In view of the foregoing amendment, authorities, remarks and the inability of the prior art to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, all the claims are submitted to be in a condition for allowance, and notice thereof is respectfully requested. Should the Examiner believe the application is not in a condition for allowance, he is respectfully requested to telephone the undersigned attorney at (617) 521-7014 to discuss what additional steps he believes would place the application in a condition for allowance.

Attached is a marked-up version of the changes being made by the current amendment.

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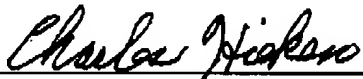
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Respectfully submitted,

FISH & RICHARDSON P.C.

Date: SEP - 6 2001

  
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